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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/775,368
Filing Date: February 10, 2004
Appellant(s): STASHLUK ET AL.

Jenni R. Moen
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 06/20/11 appealing from the Office action mailed 01/20/11 and the Advisory Action mailed on 04/07/11.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest is contained in the brief

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The copy of the appeal claims contained in the Appendix to the brief is correct.

(**8) Evidence Relied Upon**

The following is a listing of the evidence relied upon in the rejection of claims under appeal;

TSUNENARI ET AL, Patent Application Publication US 2002/0013744, filed on Feb. 23, 2001.

SAVINO ET AL, US 6,015167, filed on Aug. 14, 1998, and issued date Jan. 18, 2000.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

**1.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**2.** Claims **1-5, 7-22, 24-28, 30-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over TSUNENARI ET AL (US 2002/0013744) in view of SAVINO ET AL (US 6,015,167) and further in view of official notice.

**As for claim 1**, TSUNENARI ET AL. discloses a computer-implemented method of providing merchandise return labels for enabling a customer to ship a package

containing one or more items previously acquired from a merchant during a transaction, comprising the steps of:

1) accessing item data representing at least one detail about the item

{see at least figures 9-10g; 10i; pars. 0013; 0075, lines 1-23 discloses information about the product/item to be returned}

2) accessing transaction data representing at least one detail about the transaction associated with the item;

{see at least figures 4, 10G, 10K; pars.0034; 0075; 0083 disclose product transaction associate with the item}

3) accessing customer data representing at least one detail about a customer associated with the transaction

{see at least figures 10C, 10G, 10I, 10K; and pars. 0072, 0075, 0080-0081

4) accessing package data representing at least one detail about the package in which the item is expected to be shipped

{see at least figures 10I; 0061; 0116 discloses shipping package data}

5) using a computer operated by the merchant/manufacturer from whom the item was acquired to correlate the item data, transaction data, customer data, with a set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center

{see figures 1-3; pars. 0060-0063; 0080-0081; 0092-0094 discloses the merchant/manufacturer web server correlate the returned product information and customer information using the business rules to determine the coding to be printed on a return shipping label, e.g. based on the receiving particular returned product information from customer, *the server will determine the destination of the product in accordance with the product type sending the product to a facility at which it may be processed. the destination is defined in accordance with the location of the customer, selecting whatever suitable destination is closest to customer in order to minimize cost* (par. 0060)*; determine which carrier service is the most economical, given the nature of the product to be returned (such as its weight and dimension) and the pickup delivery points* (par. 0061); *Once the destination and a carrier service are selected, the Web server generates shipping label data. The shipping label include data sufficient for the client/consumer computer to direct a printer to print a shipping label that includes an identification of the destination and the carrier service selected, and also data necessary to print an actualization code on the label* (par. 0062-0063); *and the selection of the product destination is made by the manufacturer server on the basis of specified rules that take into consideration the geographical location of the customer and the nature of the product being returned* (see pars. 0092-0093)}.

6) using the computer operated by the merchant/manufacture from whom the item was acquired to generate machine readable code (interpreted to be second machine readable code) for the return shipping label for shipment from the customer to the return center (return facility),

{see figures 10I; pars. 0062-0063; 0081 discloses generating the shipping label as the results of the correlating step (recited item data, transaction data, customer data and package data), and the label also includes the machine readable code which contain information used by the carrier for the pick up and tracking of the parcel};

7) using the computer operated by the merchant/manufacture web server to format the return shipping label and complies with shipping labels specification of the choice of carrier, and a carrier specified machine readable code (second machine readable code) present on the shipping label

{see figure 10I; 10J, pars. 0061-0063; 0081-0082 discloses formatting the returning shipping label, and the shipping label also complies with shipping label specifications of the choice of carrier. For example, figure 10i, par. 0081 discloses "*the shipping label 1029 is in the format of the specific carrier that will do the transporting. The label 1029 includes the sender's address 1029a; the destination address 1029b; the weight of the parcel 1029c and information 1029d in the machine readable bar code used by the carrier for the pick-up and tracking of the parcel*"}. Thus, Tsunenari discloses the shipping label complies with specifications of choice of carrier and the shipping label includes a machine readable code (second readable code) that is used by the carrier.

**Note**: for convenience, numbers (1)-(7) are added to the beginning of each step.

TSUNENARI ET AL discloses the claimed invention as indicated above. For example Tsunenari discloses the shipping label contain a machine readable code (interpreted to be a second machine readable code) which contains information used by

the carrier. However, Tsunenari does not explicitly disclose the shipping label contains another machine readable code (first machine readable code) that represents at least the shipping origin of the package and the identification of the transaction; scanning the machine readable code to correlate the machine readable code with one or more business rules for performing returning processing for the merchant associated with the transaction (part of steps 2 and 3, steps 6-8).

In the similar method for generating and transmitting electronic shipping label including a barcode, SAVINO ET AL discloses a machine readable barcode included in a shipping label for coordinating shipping and receiving information between supplier and customers in order to reduce the time consuming and costly. A bar code value represents plurality of predetermined relevant purchase and shipping information associated with a purchase order such as customer name and address, packing slip number, customer purchase order number (identification transaction), part/item quantity number, customer part number, shipping information etc. The bar code can be scanned by a supplier/merchant to retrieve from the database all relevant purchase and shipping information associated with a purchase order {see figures 4-5, at least col. 2, lines 7-19; col. 3, lines 34-54, col. 4, lines 24-35}.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label contains the readable bar code used by carrier of **TSUNENARI ET AL** to include a machine readable code which represents customer address and identification of the transaction as taught by **SAVINO ET AL** for coordinating shipping and receiving information between supplier/merchant

and customers in order to reduce the time consuming and costly {see SAVINO ET AL col. 1, lines 34-50}.

Furthermore, since **TSUNENARI ET AL** teach the method of generating shipping label contains the readable bar code used by carrier and since **SAVINO ET AL** disclose a shipping label contains a machine readable bar code that represents the shipping information and identification transaction for coordinating shipping and receiving information between supplier and customer in order to reduce the time consuming and costly as shown above, therefore it would have been obvious to one of ordinary skill in the art to provide the shipping label contains the readable bar code used by the carrier of Tsunenari to include a machine readable code that represents shipping information and identification transaction as taught by SAVINO since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately e.g. putting both of the readable bar codes in the same shipping label, the content or functionality of the bar codes will not change. One of ordinary skill in the art have recognized the knowledge and ability to put the two readable codes together e.g. giving the well known nature of document creation software and printer driver software to achieve the combination of the two codes in the same shipping label would have been predictable.

Note: As for the data point about customer data such as "a shipping origin" is included in the machine readable code as recited in the claim invention, since TSUNENARI ET AL/ SAVINO ET AL discloses the machine readable code represents *various variables or aspects of purchase and shipping information of a purchase order*

*such as customer name and address, packing slips number, part quantity number, customer part number, etc.* {SAVINO ET AL at least figures 4-5, col. 3, lines 34-48; col. 4, lines 20-35}, therefore, SAVINO contemplates that the machine readable code can include other data value. Official notice is taken that shipping origin information is well known to be included in shipping label. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the data value "shipping origin" into the machine readable bar code of Tsunenari/ SAVINO to provide more complete variables or aspects of purchase and shipping information.

**As for dep. claims 2-5** which discloses the information/data about the items and the transaction, customer information, package information, this is taught in TSUNENARI ET AL {see figures 10G-10, and figures 14-15; pars. 0060-0063; 0075}.

**As for dep. claim 7**, which discloses the customer preferences/data comprising a customer selected choice of carrier, and format the return shipping label as required by the customer selected choice of carrier this is taught in TSUNENARI ET AL {see at least fig. 10i-10j, pars. 0062-0063, 0092}

**As for dep. claims 8-11**, which discloses scanning the machine readable code to identify the merchant as the payee of shipping charges, TSUNENARI ET AL/SAVINO discloses the shipping label data include an actualization code on the label indicating that the shipping of the package on which the label is affixed has been pre-authorized and that the receiver (merchant/manufacturer) will pay the shipping costs {see TSUNENARI ET AL, par. 0062, figure 10i}}; calculating or determining the shipping charge due to the carrier based on the cost of shipping package, package weight, the

package size, shipping rate and the cost of shipping package from the shipping origin associated with the customer to the merchant/manufacturer {see TSUNENARI ET AL, pars. 0061-0062, 0092 figure 10 i}.

**As for dep. claims 12-13**, which discloses carrier data location data, format the return shipping label to include the carrier center location closest to the merchant or return center as the shipping destination, this is taught in TSUNENARI ET AL {see at least figures 10 i-10j, and figures 12, 14-15; pars. 0060-0063; 0075, 0093, 0121}.

**As for dep. claim 33**, TSUNENARI ET AL/SAVINO discloses receive a return product and provide returns processing for plurality of merchants; {see TSUNENARI ET AL at least figures 14-15, pars. 0113, 0115, 0119-0120}; a data value represents the identification of the merchant in the machine readable code and scanning the machine readable code in response to receiving the package containing the item for return to identify the merchant associated with the transaction {see SAVINO at least figures 4-5, col. 3, lines 34-48; col. 4, lines 20-35}.

**As for independent claim 14**, which discloses software embodied in a memory and comprising programming operable when executed by a computer to carry the method steps of the independent claim 1. Therefore, is rejected for the same reason sets forth the independent claim 1 as stated above.

**As for dep. claim 15**, which discloses the accessing the group of information/data such as item data, customer data, transaction data via a remote data communication link, this is fairly taught in TSUNENARI ET AL {see figures 10G-10I, and figures 14-15; pars. 0060-0063; 0075}.

**As for dep. claim 16**, which discloses the shipping rate, and determine/calculate the shipping charge based on the shipping rate data and the cost of shipping the package from the shipping origin associated with the customer to the merchant/manufacture {see TSUNENARI ET AL, pars. 0061-0062, 0092, 0102 figures 10i and 12}.

**As for dep. claims 17-18**, which discloses carrier data location data, format the return shipping label to include the carrier center location closest to the merchant or return center as the shipping destination, this is taught in TSUNENARI ET AL {see at least figures 10 i-10j, and figures 12, 14-15; pars. 0060-0063; 0075}.

**As for dep. claim 19-22** which carry the similar limitations as dep. claims 2-5 above. They are rejected for the same reason sets forth dep. claims 2-5 as indicated above.

**As for dep. claims 24-27,** which carry similar limitations as dep. claims 7-10 above. They are rejected for the same reason sets forth dep. claims 7-10 as indicated above.

**As for dep. claim 34** which carry similar limitations as dep. claim 33 above. They are rejected for the same reason sets forth dep. claim 33 as indicated above.

**As for independent claim 28**, which discloses a software embodied in a memory and comprising programming operable when executed by a computer to carry the method steps of the independent claim 1. Therefore, is rejected for the same reason sets forth the independent claim as stated above.

**As for claim 30**, TSUNENARI ET AL discloses a business rules is used to access package data representing at least one detail about the package in which item is expected to be shipped {see figures 10G-10I; pars. 0075; 0080-0082; 0092-0093}

**As for dep. claims 31-32**, TSUNENARI ET AL discloses the shipping information include the choice of carrier and package information, {see figures 10G-10I; pars. 0060-0063; 0080-0081. 0092-0093}.

**As for dep. claim 35** which carry similar limitations as dep. claim 33 above. They are rejected for the same reason sets forth dep. claim 33 as indicated above.

**3.** Claims **36-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over TSUNENARI ET AL (US 2002/0013744) in view of SAVINO ET AL (US 6,015,167), official notice and further in view of WILLIAMS ET AL (US 2002/0032612).

**As for dep. claims 36-3**8, the combination of TSUNENARI ET AL, SAVINO ET AL and official notice discloses the claimed invention as indicated above. For example, TSUNENARI ET AL par. 0062 discloses the manufacturer or merchant will pay for the shipping costs to the carrier; SAVINO ET AL and official notice discloses the machine readable bar code on the shipping label contains the shipping information of a purchase order such as customer name and address, shipping information and shipping origin. The bar code can be scanned by a supplier/merchant to retrieve from the database all relevant purchase and shipping information associated with a purchase order {see figures 4-5, at least col. 2, lines 7-19; col. 3, lines 34-54, col. 4, lines 24-35}. However the combination of TSUNENARI ET AL, SAVINO ET AL and official notice do not explicitly disclose "calculating the shipping charge due to the carrier based on the

shipping origin identified as a result of scanning the machine readable code on the return shipping label".

In the similar method of generating the return shipping label, WILLIAMS ET AL discloses the merchant pays shipping charges for the return items. The system "*calculates the shipping charges based on zip-to zip pricing*" e.g. the origin zip code of the sender and the destination zip code of the receiver" { WILLIAMS ET AL see figure 71 a, pars. 0014, 0116, 0327}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the shipping label contains a machine readable bar code include the shipping origin of TSUNENARI ET AL, SAVINO ET AL and official notice to include the feature of calculating the shipping charge due to the carrier by the merchant based on the shipping origin as taught by WILLIAMS ET AL in order to provide the high quality service by paying the return shipping for the customer {see WILLIAMS ET AL par. 0014} and also because the origin information is in the bar code as modified above, then when the calculation of WILLIAMS is performed in the combination above, it would have been obvious to use the origin information in the bar code on the shipping label.

**(10) Response to Argument**

**Claim Rejections under 35 U.S.C. 103 (a)**

**With respect to Appellant's argument in section II, issue A (brief 21-22),**

"Appellant argued that *Tsunenari-Savino-Official Notice* combination does not disclose, teach or suggest a return shipping label that "complies with shipping label qualifications of the choice of carrier" and includes both "the first machine readable code not associated with the carrier" and "a second carrier specified machine readable code also present on the shipping label" as recited in independent claim 1.

To reject the claims, the Examiner relies upon *Tsunenari* for disclosure of "the return shipping label" having a "carrier-specified machine readable code" but acknowledges that *Tsunenari* "does not explicitly disclose the shipping label contains an additional machine readable code that represents at least the shipping origin of the package and the identification transaction. (Office action, pages 6 and 14-15; Advisory Action, page 2). To make up the deficiencies of *Tsunenari*, the Examiner points to *Savino* for disclosure of the "machine readable code" that is not associated with the carrier. (Office Action, pages 6-7 and 15; Advisory Action, page 2)".

Appellant also disagrees with the combination of *Tsunenari-Savino-Official Notice* as Appellant states "*Tsunenari* discloses a typical carrier shipping label, *Savino* does not at all relate to a shipping label that is included on the outside of a package. Rather, though *Savino* uses the term "shipping label", the background potion of *Savino* makes clear that the "shipping label" is merely a "packing slip" or something similar to a packing slip. (*Savino*, Column 1, lines 36-50; figure 3 and 5).

Specially, Savino describes that the label includes "a single bar code" that is "linked with purchase and shipping information associated with a purchase order" (Savino, Column 2, lines 7-10; column 3, lines 48-61).

Thus, though the label is termed a "shipping label" it is not a carrier label and has none of the user features of a shipping label. Rather, the label merely includes the bar code identifying a packing slip number and printed matter that relates to the customer purchase order no., the number of boxes, the quantity, and the customer part number. (Savino, figure 3). Accordingly, the proposed combination merely results in a package having a first shipping label with a carrier specific bard code (such as that disclosed in Tsunenari) and a second packing slip type label with an additional machine readable code (such as that discloses in Savino)".

"It remains Appellants' position that neither Tsunenari nor Savino disclose a return shipping label that "complies with shipping label specification of the choice of carrier" and includes both "the first machine readable code not associated with the carrier" and "a second carrier-specified machine readable code also present on the shipping label" as recited in Claim 1".

"The Examiner has answered that "the instant claim language failed to provide specific structure and functional distinction between the claimed "shipping label" and that of Tsunenari/Savino". (Office Action, page 17; Advisory Action, page 2). Appellants respectfully disagree. Appellants' claim 1 recites "using the computer....to generate a machine readable code **for the return shipping label for shipment from the customer to the returns center"**. As such, Appellants claims do recite specific structure and functional distinction between the claimed "shipping label" and the labels disclosed in *Tsunenari* and *Savino*". Because neither reference nor their proposed combination discloses a return shipping label that "complies with the shipping label specifications of the choice the carrier" and includes both "a first machine readable code" and a "second carrier-specified machine readable code," Appellant's respectfully submit that Claim 1 is allowable over the proposed *Tsunenari-Savino-Official Notice* combination".

In response to Appellant's argument as shown above, the Examiner respectfully disagrees for the following reasons:

1) The reference of *Tsunenari* is applied to disclose formatting the return shipping label that complies with shipping label specification of the choice of carrier include the second carrier specified machine readable code. For example *Tsunenari* at least figures 10i, 10j and pars. 0081-0082 discloses "the shipping label 1029 is in the format of the specific carrier that will do the transporting. The label 1029 includes the sender's address 1029a; the destination address 1029b; the weight of the parcel 1029c and information 1029d in the machine readable bar code used by the carrier for the pick-up and tracking of the parcel"}. Thus, *Tsunenari* discloses the shipping label complies with specifications of choice of carrier and the shipping label includes a machine readable code (second readable code) that is used by the carrier.

*Tsunenari* does not explicitly disclose the shipping label contains another machine readable code (first machine readable code) that represents at least the shipping origin of the package and the identification of the transaction;

In the similar method for generating and transmitting electronic shipping label including a barcode, SAVINO ET AL is used to apply a machine readable barcode included in a shipping label for coordinating shipping and receiving information between supplier and customers in order to reduce the time consuming and costly. A bar code value represents plurality of predetermined relevant purchase and shipping information associated with a purchase order such as customer name and address, packing slip number, customer purchase order number (identification transaction), part/item quantity number, customer part number, shipping information etc. The bar code can be scanned by a supplier/merchant to retrieve from the database all relevant purchase and shipping information associated with a purchase order {Savino et al figures 4-5, at least col. 2, lines 7-19; col. 3, lines 34-54, col. 4, lines 24-35}.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label contains the readable bar code used by carrier of **TSUNENARI ET AL** to include a machine readable code which represents customer address and identification of the transaction as taught by **SAVINO ET AL** for improving the coordinating shipping and receiving information between supplier/merchant {see SAVINO ET AL col.1, lines 34-55}.

Furthermore, since **TSUNENARI ET AL** teaches the method of generating shipping label contains the readable bar code used by carrier and since **SAVINO ET AL**

discloses a shipping label contains a machine readable bar code that represents the shipping information and identification transaction for coordinating shipping and receiving information between supplier and customer as shown above, therefore it would have been obvious to one of ordinary skill in the art to provide the shipping label contains the readable bar code used by the carrier of Tsunenari to include a machine readable code that represents shipping information and identification transaction as taught by SAVINO since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately e.g. putting both of the readable bar codes in the same shipping label, the content or functionality of the bar codes will not change. One of ordinary skill in the art have recognized the knowledge and ability to put the two readable codes together e.g. giving the well known nature of document creation software and printer driver software to achieve the combination of the two codes in the same shipping label would have been predictable.

**Note**: As for the data point about customer data such as "a shipping origin" is included in the machine readable code as recited in the claim invention, since TSUNENARI ET AL/ SAVINO ET AL discloses the machine readable code represents *various variables or aspects of purchase and shipping information of a purchase order such as customer name and address, packing slips number, part quantity number, customer part number, etc.* {SAVINO ET AL at least figures 4-5, col. 3, lines 34-48; col. 4, lines 20-35}, therefore, SAVINO contemplates that the machine readable code can include other data value. Official notice is taken that shipping origin information is well

known to be included in shipping label. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the data value "shipping origin" into the machine readable bar code of Tsunenari/ SAVINO to provide more complete variables or aspects of purchase and shipping information.

**Further Note:** As for the Official Notice statement which indicates shipping origin is old and well known to be included in the shipping label as shown above, it is noted that Appellant did not further challenge the official notice in the brief. See the office action (dated 01/20/11) and the advisory action (dated 04/07/11) in responses to Applicant's challenge on official notice (remark dated 11/05/10 and 03/17/11).

2) Appellant asserts that the label in Savino is termed a "shipping label", it is not a carrier label and has none of the usual features of a shipping label instead the "shipping label" is merely a "packing slip" or something similar to a packing slip. Appellant also asserts that the claims do recite specific structure and functional for example "using the computer ....to generate a machine readable code **for the return shipping label for shipment from the customer to the returns center**" which provides a distinction between the claimed "shipping label" and the labels discloses in Tsunenari and Savino. This is not persuasive because "the return shipping label for shipment from the customer to returns center" is considered as intended use limitation and does not provide the distinction in structure and function between the claimed "shipping label" and the label disclosed in Tsunenari and Savino. For example, Appellant's claimed invention does not specify of how the shipping label is used e.g. how the shipping label is attached to the container, box or merchandise or what usual

features of a shipping label is distinguish with the shipping label in combination of Tsunenari and Savino. For the sake of an argument, assuming the shipping label in Savino is not a shipping label according to the Appellant's assertion, the term "shipping label" in Savino is still broadly read over the "shipping label" as claimed because Savino clearly identifies "the shipping label contains a bar code for coordinating shipping and receiving information between customer and supplier" as shown in col. 1, lines 59-67; col. 2, lines 1-19 and thus teaches the structure and function claimed.

As a result, the combination of Tsunenari, Savino and Official Notice discloses a return shipping label that "complies with shipping label specifications of the choice of carrier" and includes both "the first machine readable code not associated with the carrier" and "a second carrier-specified machine readable code also present on shipping label" as recited in Claim 1.

**With respect to Appellant's argument in section II, issue B (brief 23-24),**

Appellant argued that "The proposed Tsunenari-Savino-Official Notice combination is improper".

In the Office Action, the Examiner states that "It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label contains the readable bar code used by carrier of *Tsunenari* to include a machine readable code which represents customer address and identification of the transaction as taught by *Savino et al* for coordinating shipping and receiving information between supplier/merchant and customers in order to reduce the time consuming and costly" (Office Action, page 6-8). It remains Appellant's position, however, that Savino teaches away from the proposed combination.

Savino specifically relates to a "single bar code shipping label" (Savino, column 2, lines 7-10, emphasis added). Throughout, Savino praises a label that includes a single bar code. According to

Savino, "if for example, nine bar codes are provided with each packing slip, it will typically take about one minute to scan-in each nine block label". (Savino, Column 1, lines 43-45). As another example, Savino explains that "several bar codes increase the likelihood that one or more of the bar codes provides incorrect information". (Savino, Column 1, lines 48-50). With regard to previous packing slips, Savino discloses that a "drawback is that the packing slip supplied with each purchase order typically includes several bar codes that are scanned slip supplied with each purchase order typically includes several bars codes that are scanned by the customer if equipped with an automated receiving system". (Savino, Column 1, lines 36-38). Thus, Savino actually teaches a way from shipping label that includes more than one bar code. As a result, Savino teaches away from modifying the carrier specific bar code of Tsunenari to include an additional merchant specific bar code.

The proposed combination does not disclose "the return shipping label contains the first machine readable code and complies with shipping label specifications of the choice of carrier, the first machine readable code not associated with the carrier and in addition to a second carrier specified machine readable code also present on the shipping label" as recited in claim 1.

In response to Appellant's argument that Savino teaches away from shipping label that includes more than one bar code since Savino only discloses a shipping label that includes a single bar code, the Examiner respectfully disagrees with Appellant's assertion because SAVINO discloses a system of employing a single bar code provided on a shipping label for coordinating shipping and receiving information between supplier and customer, whereby data value in the single bar code represents a purchase and shipping information of a purchase order such as customer name and address, packing slip number, customer purchase order number and etc {see figures 4-5, at least col. 2, lines 7-19; col. 3, lines 34-54, col. 4, lines 24-35}. This single bar code is scanned and used by the supplier or customer for coordinating shipping and receiving information, but does not provide for the actual delivery. There is no specific provision for postage,

package weight or other data typically employ by a carrier for delivery {see SAVINO col. 1, lines 59-67; col. 2, lines 1-6}. Thus, the single bar code of SAVINO would not typically be the only bar code on the package being delivered. The package being delivered would have obviously also contain another machine readable code that being used by a carrier for delivery.

Since Savino does not teach away from shipping label that includes more than one bar code, therefore the combination of *Tsunenari, Savino and Official Notice* discloses a return shipping label that "complies with shipping label specifications of the choice of carrier" and includes both "the first machine readable code not associated with the carrier" and "a second carrier-specified machine readable code also present on shipping label" as recited in Claim 1.

**With respect to Appellant's argument in section III, claims 7 and 24 (brief 24-25).**

Appellant states:

Dependent Claims 7 and 24 depend upon independent Claims 1 and 14, respectively. Accordingly, dependent Claims 7 and 24 are not obvious over the proposed *Tsunenari- Savino-Official Notice* combination at least because Claims 7 and 24 include the limitations of their respective independent claims, which Appellants have shown above to be allowable.

Additionally, Claims 7 and 24 recite claim elements that further distinguish over the art. For example, Claim 7 recites that "the customer data represents customer preferences, at least one customer preference comprising a customer-selected choice of carrier" and that the method further includes "using the computer . . . to format the return shipping label as required by the customer-selected choice of carrier." In the *Office Action*, the Examiner identifies *Tsunenari*, specifically, for disclosure of the recited claim elements. (Final Office Action, p. 8). Appellants respectfully disagree.

Rather, Tsunenari discloses that "maintained in the database server 150 is a list of all carrier services, and their charges for specified transports." (*Tsunenari*, paragraph 61). According to Tsunenari, "[t]he Web server 110 accesses this information as well, to determine which carrier service is the most economical, given the nature of the product to be returned (such as its weight and dimensions) and the pick-up and delivery points." (*Tsunenari*, paragraph 61). "Once a destination and a carrier service are selected, the Web server generates shipping label data ($250)." (*Tsunenari*, paragraph 62). Thus, Tsunenari merely discloses that the Web server automatically selects the most economical carrier. There is no disclosure in Tsunenari of "customer data [that] represents **customer preferences**" wherein " at least one customer preference compris[es] **a customer-selected choice of carrier,**" as recited in Claim 7. Likewise, Tsunenari does not disclose, teach, or suggest "using the computer . . . to format the return shipping label as required **by the customer-selected choice of carrier,**" as recited in Claim 7. Because Savino and Official Notice do not cure these identified deficiencies of Tsunenari, Appellants respectfully submit that Claim 7 is allowable over the proposed *Tsunenari-Savino-Official Notice* combination.

For at least these reasons, Appellants respectfully submit that the rejection of Claim 7 is improper and should be withdrawn. For analogous reasons, Appellants also submit that the rejection of Claim 24 is also improper and should be withdrawn.

In response to Applicant's argument as shown above that Tsunenari-Savino-Official Notice combination does not teach claims 7 and 24 "*wherein the customer data represents customer preferences, at least one customer preferences comprise customer selected choice of carrier; using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to format the return shipping label as required by the customer selected choice of carrier*", the Examiner respectfully disagrees because:

Tsunenari discloses customer preference data (customer's address) is a factor in choosing the selected carrier as shown in figure 10i, 10J and 11B par. 0092. Looking at

the manipulative steps of the claimed invention, Appellant's claim effectively indicates the system merely accesses the customer data, determines the carrier based on the customer data, and then formats the shipping label based on the determined customer data. These are the only positively recited actions. The Examiner asserts that there is no explicit step that indicates the use of selecting a carrier according to customer preference, and the implied meaning of the customer preference merely to the human mind does not make a manipulative difference in the action performed (no patentable difference in formatting the shipping label).

Since Tsunenari {figures 10i, 10J and 11B, pars 0081-0082 and 0092} discloses the computer system has customer data represents customer location, then the customer location is used to select the carrier and the computer system formats the shipping label according to the carrier selected, therefore Tsunenari discloses all the positively recited actions in claims 7 and 24.

**With respect to Appellant's argument in section IV, claims 12-13 and 17-18 (brief 24-25).**

Appellant states:

Dependent Claims 12-13 and 17-18 depend upon independent Claims 1 and 14, respectively. Accordingly, dependent Claims 12-13 and 17-18 are not obvious over the proposed *Tsunenari-Savino-Official Notice* combination at least because Claims 12-13 and 17-18 include the limitations of their respective independent claims, which Appellants have shown above to be allowable.

Additionally, Claims 12-13 and 17-18 recite claim elements that further distinguish over the art. For example, Claim 12 recites that "using the computer associated with the merchant or the specialized return center to format the return shipping label to include a carrier center location closest to the merchant or the specialized returns center as the shipping destination such that the package is delivered to the

carrier center location and picked up by the merchant or the specialized returns center." Claim 13 further recites that the "carrier center location closest to the merchant or the specialized returns center is a bulk mail center." Claims 17 and 18 recite certain similar claim elements. In the *Office Action*, the Examiner identifies *Tsunenari*, specifically, for disclosure of the recited claim elements. (*Final Office Action, p. 9*). Appellants respectfully disagree.

Rather, as discussed above, *Tsunenari* merely discloses that "maintained in the database server 150 is a list of all carrier services, and their charges for specified transports." (*Tsunenari*, paragraph 61). According to *Tsunenari*, "[t]he Web server 110 accesses this information as well, to determine which carrier service is the most economical, given the nature of the product to be returned (such as its weight and dimensions) and the pick-up and delivery points." (*Tsunenari*, paragraph 61). Thus, Tsunenari merely discloses that the Web server automatically selects the most economical carrier. With regard to the final destination of the package, Tsunenari discloses that the "Web server selects a product return destination for the consumer product.., in accordance with the product type sending the product to a facility at which it may be processed." (*Tsunenari*, paragraph 60). As an example, Tsunenari discloses that "in the case of a laser toner cartridge being returned fro recycling, a destination will be chosen at which the recycling can be done." (*Tsunenari*, paragraph 60). Additionally, Tsunenari discloses that the designation may be "further refined in accordance with the location of the consumer, selecting whatever suitable destination is closest to the consumer in order to minimize shipping costs." (*Tsunenari*, paragraph 60). Thus, *Tsunenari* discloses that the final destination is chosen based on the type of product or the location of the customer. *Tsunenari does not* disclose that the final destination printed on the return shipping label is that of a "**carrier center location**," as recited in Claim 12. Likewise, *Tsunenari does not* disclose, teach, or suggest "format[ting] the return shipping label to include a carrier-center location **closest to the merchant or the specialized returns center** as the shipping destination **such that the package is delivered to the carrier center location** and picked up **by the merchant or the specialized returns center**," as recited in Claim 12. Additionally, though Tsunenari discloses that multiple items may be returned in bulk rather than individually (Tsunenari, paragraph 75), Tsunenari does not disclose that the carrier center location "is a bulk mail center," as recited in Claim 13.

For at least these reasons, Appellants respectfully submit that the rejections of Claims 12-13 are improper and should be withdrawn. For analogous reasons, Appellants also submit that the rejections of Claims 17-18 are also improper and should be withdrawn.

In response to Applicant's argument above that Tsunenari-Savino-Official Notice combination does not teach claims 12-13, 17-18 "using the computer associated with the merchant or the specialized return center to format the return shipping label to include *a carrier center location closest to the merchant or specialized returns center as the shipping destinations such the package is delivered to the carrier center location and pickup by the merchant or specialized returns center*", the Examiner respectfully disagrees because:

1) *Tsunenari* teaches the computer system formats the shipping return label which includes the central facility (shipping destination). The return shipping label is going to the centralized facility which does not appear to be the merchant location as shown in Tsunenari pars. 0093, 0121 and figures 10i, 11B (step 1137) and figure 15 e.g. *all products of type A that are being returned by a consumer in the United States west of the Mississippi River go to facility in Los Angeles; all products of type A that are being returned by a consumer in the United States east of the Mississippi go to a facility in New York; all products of type B that are being returned by a consumer in the United States west of Mississippi go to facility in San Francisco; and all products of type B that are being returned by a consumer in the United States east of the Mississippi go to a facility in Miami.* As shown above, *Tsunenari* teaches the return label is going to the central facility that does not appear to be the merchant location and the mere ownership of this facility either by the carrier or the merchant does not seem to impact the

manipulative action of "formatting the return shipping label to include a carrier center location".

2) Furthermore, the term "*a carrier center location closet to the merchant or the specialized returns center as the shipping destination*" as recited appears to imply a step of determining the closest carrier center location to the merchant center or the return center, however this limitation is not positively recited. There's no explicitly recited step of determining the carrier location closest to the merchant, instead the positive recited action is merely formatting the return shipping label which is taught in the reference of Tsunenari. In other words, what this destination address means to the human mind does not provide a patentable distinction. Therefore in light of the reasons explained above, the combination of Tsunenari-Savino and Official Notice teaches the claimed invention as recited in claims 12-13, and 17-18.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,

/THUY VI NGUYEN/

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